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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte CHRISTOPHER C. WINSLADE
and
JAMES D. BENNETT

Appeal 2012-003793
Application 09/687,499
Technology Center 3600

Before MURRIEL E. CRAWFORD, BIBHU R. MOHANTY, and
MICHAEL W. KIM, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

The Appellants seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 34-39 which are all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM-IN-PART.

THE INVENTION

The Appellants' claimed invention is directed to a computerized method of processing a promotion from a first party through a second party (Spec. 7). Claim 34, with the numbering in brackets added, is representative of the subject matter on appeal.

34. A method of processing a promotion from a first party, the first party having a first system, the method comprising:

[1] offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system;

[2] providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system, [3] the promotion having a promotion amount;

receiving, by the second system an online purchase request from the customer for the item for sale;

responding, by the second system, to the online purchase request by collecting from the customer a purchase amount corresponding to the sales price amount less the promotion amount; and

electronically communicating, by the second system to the first system, an indication regarding the collection from the customer of the purchase amount.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the rejections:

Holda-Fleck	US 5,729,693	Mar. 17, 1998
Meyer	US 6,915,271 B1	Jul. 5, 2005
Murphy	US 2002/0052778 A1	May 2, 2002

The following rejections are before us for review:

1. Claims 34 and 35 are rejected under 35 U.S.C. § 102(e) as anticipated by Meyer.
2. Claims 36-39 are rejected under 35 U.S.C. § 103(a) as unpatentable over Meyer and Murphy.
3. Claims 36 and 39 are rejected under 35 U.S.C. § 103(a) as unpatentable over Meyer and Holda-Fleck.

FINDINGS OF FACT

We find that the findings of fact used in the Analysis section below are supported at least by a preponderance of the evidence.¹

¹ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

ANALYSIS

Rejection of Claim 34 under 35 U.S.C. § 102(e)

Appellants argue that Meyer fails to disclose claim limitations [1] and [2] as cited above, because these limitations require that the customer must first pick the item for sale and only then search for a promotion. (App. Br. 9; Reply Br. 2-3.) In contrast, the Examiner has asserted that the cited claim limitations are shown at Figures 31-35 (Ans. 5).

We agree with the Examiner. Claim limitations [1] and [2] require:

[1] offering, by a second system of a second party, an item for sale online at a sales price amount, wherein the item for sale can be identified on the second system by a customer using the second system;

[2] providing, by the second system, a portal containing a plurality of promotions wherein the customer can search for a promotion from the first party associated with the item for sale, wherein the customer can search for the promotion after the customer has identified the item for sale on the second system. [(Claim 34).]

We begin with claim construction, and with pages 14-15 of the Specification, which describe an embodiment where the customer may retrieve rebates and coupons from the system and save them on the computer hard disk for subsequent submission to the system for online sales. This embodiment does not require that the customer must first pick the item for sale and only then search for a promotion. Thus, we construe claim limitation [2] to be broad enough to allow searching the previously selected promotion again, perhaps for verification of the promotion after identifying an item placed in an online cart to buy. Here, Meyer at Figures 31-35 shows an online second system (iSave Central) offering items for sale from a first party (Target, Holt, etc.) with a series of promotions (*see* Figs. 31 and 33)

which would meet the cited claim limitations [1] and [2]. For these reasons the rejection of claim 34 is sustained.

Rejection of Claim 35 under 35 U.S.C. § 102(e)

Appellants argue that Meyer fails to disclose *inter alia* the step of “causing, by the second system, shipment by the second party of the item for sale to the buyer,” as recited by claim 35. (App. Br. 16; Reply Br. 9.) In contrast, the Examiner has determined that the cited limitation is shown in Meyer at col. 41:22-40 (Ans. 6).

We agree with the Appellants. Claim 35 requires that the second system “caus[e] . . . shipment by the second party,” however, the portion of Meyer relied on by the Examiner clearly states that it is the vendor, or first party who ships the item to the buyer (col. 41:26-36). While the Examiner contends that in Meyer, the first party and second party can be the same (Ans. 12), we find such a contention ignores the express limitation of claim 35 which recites, “wherein the second system is distinct from the first system and the second party is distinct from the first party.” For these reasons, the rejection of claim 35 is not sustained.

Rejection of Claims 36-39 under 35 U.S.C. § 103(a) over Meyer and Murphy

Appellants argue that the combination of Meyer and Murphy fails to teach or suggest *inter alia* the step of “offering, by a second system of a second party, an item for sale online, **wherein the item has been acquired by the second party from the first party**” (emphasis original). (App. Br. 17). In contrast, the Examiner has determined that the cited claim limitation

is shown in Meyer at col. 40:67-41:2. We agree with the Appellants that Meyer at column 40, line 67 to column 41, line 2 does not show the cited claim limitation. The Examiner at pages 12-13 of the remarks further refer to Meyer as disclosing the cited claim limitation, but without providing citations to the reference itself. Regardless, these remarks do not persuasively account for the cited claim limitation. For example, simply pressing a “Buy it Now” button does show the cited claim limitation. For these reasons, this rejection is not sustained.

Rejection of Claims 36 and 39 under 35 U.S.C. § 103(a) over Meyer and Holda-Fleck.

Appellants argue that the combination of Meyer and Holda-Fleck fails to teach or suggest the subject matter of claims 36 and 39 for the same reason identified *supra* with respect to the combination of Meyer and Murphy. (App. Br. 20.) As set forth above, we agree with the Appellants that the Examiner has failed to demonstrate that Meyer teaches or suggest that the “the item [being offered, by a second system of a second party] has been acquired by the second party from the first party,” as independent claim 36 requires. The Examiner does not rely on Holda-Fleck to address this limitation.

For these reasons, and the reasons discussed *supra*, the rejection of claims 36 and 39 under 35 U.S.C. § 103(a) as unpatentable over Meyer and Holda-Fleck is not sustained.

DECISION

We affirm the rejection of claim 34 under 35 U.S.C. § 102(e) as anticipated by Meyer.

We reverse the rejection of: claim 35 under 35 U.S.C. § 102(e) as anticipated by Meyer; claims 36-39 under 35 U.S.C. § 103(a) as unpatentable over Meyer and Murphy; and claims 36 and 39 under 35 U.S.C. § 103(a) as unpatentable over Meyer and Holda-Fleck.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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